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MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC 8321 OLD COURTHOUSE ROAD SUITE 200 VIENNA, VA 22182-3817				
			EXAMINER	
			DOTE, JANIS L	
			ART UNIT	PAPER NUMBER
			1756	

DATE MAILED: 07/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/662,340

Applicant(s)

KOBAYASHI ET AL.

Examiner

Janis L. Dote

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-14 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-14 is/are rejected.
- 7) ☒ Claim(s) 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The examiner acknowledges the amendments to claims 1, 5, and 9-13, the cancellation of claims 15, 16, and 18, and the addition of claim 20 set forth in the amendment filed on May 16, 2006. Claims 1, 3-14, and 20 are pending.

2. The restriction of claims 16 and 18 set forth in the previous office action mailed on Feb. 16, 2006, has been mooted by cancellation of claims 16 and 18 filed on May 16, 2006.

3. The rejections of claims 9-13 and 15 under 35 U.S.C. 112, second paragraph, set forth in the office action mailed on Feb. 16, 2006, paragraph 7, have been withdrawn in response to the amendments to claims 9-13 and the cancellation of claim 15 filed on May 16, 2006.

The rejection of claims 9, 11, and 13 under 35 U.S.C. 102(b) over US 5,605,778 (Onuma), as evidenced by Schaffert, and the rejection of claim 10 under 35 U.S.C. 103(a) over Onuma, set forth in the office action mailed on Feb. 16, 2006, paragraphs 12 and 14, respectively, have been withdrawn in response to the amendments to claims 9-11 and 13 filed on May 16, 2006. Amended claim 9 now requires that the plurality of waxes comprise a synthetic wax and a natural wax comprising an animal wax, mineral wax, and petroleum wax. Amended claim 10

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requires that the plurality of waxes comprise a natural wax and a synthetic wax comprising a Fischer-Tropsch wax and polyethylene wax. Amended claim 13 requires that the plurality of waxes comprises polyethylene wax, a paraffin wax, alpha olefin wax, and a Fischer-Tropsch wax. In other words, claims 9 and 13 require that the plurality of waxes comprise four waxes having different compositions; while claim 10 requires three waxes having different compositions. Amended claim 11 requires that the fixing resin comprise all of the twenty-one resins recited in claim 11. Onuma does not teach or suggest a toner comprising a wax that comprises any of the combinations of waxes recited in instant claims 9, 10 and 13. Nor does Onuma teach or suggest that it toner comprise a fixing resin that comprises all twenty-one resins recited in claim 11.

The rejection of claims 1, 3, 6, 11, 12, and 14 under 35 U.S.C. 102(e) over US 6,808,851 B2 (Bartel), as evidenced by the other cited references, set forth in the office action mailed on Feb. 16, 2006, paragraph 16, has been withdrawn because of applicants' filing of an English-language translation of the certified copy of the priority document Japanese Application Number 2002-275451 on May 16, 2006, which Mr. Scott Tulino (Reg. No. 48,317) states is a "true English translation of the Japanese Application Number 2002-275451." (The examiner notes

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that the Declaration of Shinichiro Ohta dated March 11, 2003, is not present in the case.) Applicants have perfected their claim to foreign priority under 35 U.S.C. 119 for the subject matter recited in instant claims 1, 3, 6, 11, 12, and 14. The English-language translation of the priority document Japanese Patent Application 2002-275451 filed on May 16, 2006, provides antecedent basis as set forth under 35 U.S.C. 112, first paragraph, for the subject matter recited in instant claims 1, 3, 6, 11, 12, and 14. Accordingly, Bartel is no longer prior art with respect to the subject matter recited instant claims 1, 3, 6, 11, 12, and 14.

The rejection of claim 13 under 35 U.S.C. 102(e) over Bartel, as evidenced by the other cited references, and the rejection of claim 15 under 35 U.S.C. 102(e)/103(a) over Bartel, as evidenced by the other cited references, set forth in the office action mailed on Feb. 16, 2006, paragraph 16 and 17, respectively, have been withdrawn in response to the amendment to claim 13 and the cancellation of claim 15 filed on May 16, 2006. Amended claim 13 now requires that the plurality of wax components comprise all four of the waxes recited in the claim, i.e., polyethylene wax, a paraffin wax, alpha olefin wax and a Fischer-Tropsch wax. Bartel does not teach or suggest a toner comprising a wax that comprises all of the four waxes recited in

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instant claim 13, where the combination of waxes satisfies formula (2) recited in instant claim 1, from which claim 13 depends.

4. The amendment filed on Dec. 9, 2004, is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The amended paragraph beginning at page 29, line 12, of the specification, states that the toner comprises 84 wt% of the styrene-acryl copolymer resin.

The originally filed specification at page 29, line 12, discloses that the toner components comprise "85 wt%" of the styrene-acryl copolymer resin, 1 wt% of a charge control agent, 10 wt% of a carbon black, 4.5 wt% of a polyethylene wax, and 0.75 wt% of a paraffin wax.

There is no evidence on the present record showing that the amount of the styrene-acryl copolymer is 84 wt% as stated in the amended paragraph.

Applicants are required to cancel the new matter in the reply to this Office Action.

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Applicants' arguments filed on May 16, 2006, have been fully considered but they are not persuasive.

Applicants assert that the amendment changing the fixing resin amount from "85 wt%" to -- 84 wt% -- merely corrected an apparent typographic error.

Applicants' comments are not persuasive. As discussed in the objection above, the toner comprises five toner components at particular amounts. Applicants have not pointed to anything in the originally filed specification that a person having ordinary skill in the art would have recognized that the typographic error was in the fixing resin amount of "85 wt%," and not in the amounts of one or more of the other four remaining toner components.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1 and 3-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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(1) Claims 1 and 5 are indefinite because it is not clear what is meant by the phrase "a rationalized molecular weight distribution by including an appropriate amount of a low molecular weight wax component in said wax to maintain sufficient fixing performance." The instant specification at page 11, lines 14-20, does not define the term "rationalized molecular weight distribution."

(2) Claim 12 is indefinite in the phrase "fixing resin comprises one of styrene copolymer and polyester resin" because it is outside the scope of claim 11, from which claim 12 depends. Claim 11 requires that the fixing resin comprises all of the twenty-one resins recited in instant claim 11, not such the two resins recited in instant claim 12.

Applicants' arguments filed on May 16, 2006, applicable to item (1) above have been fully considered but they are not persuasive.

Applicants assert that one of ordinary skill in the art would understand the meaning of the phrase "rationalized weight distribution" in view of the supporting disclosure provided at page 10, line 18, to page 11, line 20."

Applicants' assertion is not persuasive. The disclosure at page 10, line 18, to page 11, line 20, is not in idiomatic English. It is not readily apparent what is the definition of

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the term "rationalized molecular weight distribution."

Applicants merely assert that the term is defined in the instant specification, but they do not clearly state what is the definition of the term. Accordingly, the rejection stands.

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 8-10 and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(1) Claims 8-10 recite that the plurality of wax components comprises "one of a natural wax and a synthetic wax" (emphasis added).

The originally filed specification does not provide an adequate written description of said plurality of wax

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components. The originally filed specification at page 15, lines 19-20, discloses that the "wax can be obtained from the natural wax or the synthetic wax" (emphasis added). Examples 1 and 2 exemplify two particular wax mixtures comprising a particular polyethylene wax and a particular paraffin wax that have particular crystallinities and melting points. The two particular wax mixtures do not provide an adequate written description for the broader species recited in the instant claims.

(2) Claim 13 recites that the plurality of wax components comprises "one of . . . alpha olefin wax."

The originally filed specification does not provide an adequate written description of said alpha olefin wax. The originally filed specification at page 15, lines 19-23, discloses that the "wax can be obtained from the natural wax or the synthetic wax," where the synthetic wax can be a Fischer-Tropsch wax or polyethylene wax. Example 3 exemplifies a particular alpha-olefin wax that has a particular crystallinity and melting point. The one particular alpha-olefin wax does not provide an adequate written description for the broader species of alpha-olefin wax recited in the instant claim. The term "alpha-olefin wax" recited in instant claim 13 is broader than the particular crystalline alpha-olefin wax exemplified in

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example 3 of the specification, because it encompasses alpha-olefin waxes that do not have the particular crystallinity and melting point of the exemplified wax.

(3) Claims 9, 10, and 13 require that the plurality of wax components comprise all of the recited waxes in those claims. In other words, the plurality of wax components recited in instant claims 9, 10, and 13 are required to comprise either four, three, or four waxes, respectively, having different compositions.

The originally filed specification does not provide an adequate written description of said plurality of wax components. The originally filed specification at page 15, lines 19-20, discloses that the "wax can be obtained from the natural wax or the synthetic wax" (emphasis added). The originally filed specification at page 15, lines 20-23, discloses that the synthetic wax can be a Fischer-Tropsch wax or a polyethylene wax and that the natural wax can be an "animal/plant wax," mineral wax or a petroleum wax. Examples 1 and 2 exemplify two particular wax mixtures comprising a particular polyethylene wax and a particular paraffin wax that have particular crystallinities and melting points. The originally filed specification does not disclose a plurality of

waxes comprising all of the waxes recited in instant claims 9, 10, and 13.

Applicants' arguments filed May 16, 2006, have been fully considered but they are not persuasive.

Applicants assert that the specification at page 15, lines 19-23, provides clear support for the limitations recited in instant claims 8-10. Applicants submit that examples 1 and 2 are merely non-limiting examples of certain exemplary embodiments of the invention.

Applicants' arguments are not persuasive for the reasons of record discussed in items (1) and (3) above. Instant claim 8 does not recite that the plurality of wax components comprises a natural wax or a synthetic wax as alleged by applicants. Rather, instant claim 8 recites that the "plurality of wax components comprise one of a natural wax and a synthetic wax" (emphasis added). In other words, the plurality comprises both a natural wax and a synthetic wax. As discussed in item (3) above, the plurality of wax components recited in instant claims 9, 10, and 13 are required to comprise either four, three, or four waxes, respectively, having different compositions. As discussed in items (1) and (2) above, the originally filed specification at page 15, lines 19-23, merely discloses that the wax can be a natural wax or a synthetic wax;

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and provides a list of various natural waxes and synthetic waxes. There is no general disclosure in the originally filed specification of the combination of the waxes as broadly recited in instant claims 8-10. The examples in the specification only provide an adequate written description for those particular wax mixtures exemplified or particular waxes exemplified in the examples. Applicants have not pointed to any disclosure in the originally filed specification that provides an adequate written description of a plurality of wax components comprising all two waxes, all four waxes, all three waxes, or all four waxes as broadly recited in instant claims 8, 9, 10, and 13, respectively.

With respect to item (2), applicants have not pointed to any disclosure in the originally filed specification that provides an adequate written description for the generic "alpha olefin wax" recited in instant claim 13.

Accordingly, the rejections of claims 8-10 and 13 stand.

9. Claim 20 is objected to because of the following informalities:

At line 10, delete the term "~~and~~".

Appropriate correction is required.

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10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. In the interest of compact prosecution, the examiner has interpreted the claim limitation in claims 1 and 5, "rationalized molecular weight distribution by including an appropriate amount of a low molecular weight wax component in said wax to maintain sufficient fixing performance" as being met by any combination of waxes that provides "sufficient fixing performance."

Rejections based on this interpretation are set forth infra.

12. Claims 1, 5-8, 12, and 14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US 5,605,778 (Onuma), as evidenced by Schaffert, Electrophotography, page 604, Fig. 248.

Onuma discloses a toner comprising 100 parts by weight of styrene-n-butyl acrylate binder resin **1** and 4 parts by weight of a wax mixture comprising a plurality of waxes. The wax mixture comprises paraffin wax **J** and polypropylene wax **K**, in a weight ratio of 1:1. Col. 18, lines 50-58; col. 18, line 62, to col. 19, line 8; col. 19, lines 25-44; example 9 at col. 21,

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lines 55-58; and Table 2, example 9. Onuma further teaches that that the binder resin of the toner can preferably be a mixture of the styrene copolymer and a polyester resin "in respects of the developing performance, fixability, durability, and cleaning performance." Col. 11, lines 49-50 and 53-55. The mixture of resins meets the fixing resin limitation recited in instant claim 12. Onuma further discloses an image forming apparatus - a commercially available electrophotographic copying machine NP-4835 manufactured by Canon K.K., which comprises an OPC (organic photoconductor) photosensitive drum, i.e., an electrostatic charge holding member, and the toner in example 9. Col. 19, line 62, to col. 20, line 12. Although Onuma does not explicitly disclose that the apparatus comprises a developing unit, it is well-known in the electrophotographic arts that commercially available electrophotographic copying machines comprise a developing unit. See Schaffert, Electrophotography, page 604, Fig. 248, which shows the schematic diagram of a XEROX 914 copier. Thus, the Onuma image forming apparatus comprises a developing device unit as recited in instant claim 5.

The wax mixture in the example 9 toner is present in the amount of 3.8 wt% based on the weight of the binder resin and the wax, which is within the ranges of 0.5 to 10 wt% and 3.0 to 6.0 wt%, based on the weight of the fixing resin and wax in

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instant claims 6 and 7, respectively. The amount 3.8 wt% was determined from the information provided at col. 19, lines 25-44.

Paraffin wax **J** has a maximum heat absorption peak, i.e., melting point, of 62°C, which is within the range of 50 to 120°C recited in instant claim 1. See Table 1, wax **J**. Paraffin wax **J** and polypropylene wax **K** meet the wax compositional limitations recited in instant claim 8. Paraffin wax **J** exhibits on onset temperature of heat absorption (T_n) in a DSC curve at 54°C. Polypropylene wax **K** exhibits on onset temperature of heat absorption in a DSC curve at 133°C. See Table 1 at col. 23, waxes **J** and **K**. The Onuma toner in example 9 satisfies formulas (1) to (3) recited in instant claims 1 and 5. "T" in formula (1) is 93.5°C (i.e., $[54^\circ\text{C} \times 50 \text{ wt}\% + 133^\circ\text{C} \times 50 \text{ wt}\%]/100 \text{ wt}\%$). The "T" value of 93.5°C is greater than 56, so the inequality in formula (2) is satisfied.

Onuma does not explicitly disclose that its particular combination of waxes comprise a "rationalized molecular weight distribution by including an appropriate amount of a low molecular weight wax component in said wax to maintain sufficient fixing performance" as recited in instant claims 1 and 5. However, Onuma shows that the toner comprising its particular combination of waxes provides toner images that have

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excellent low-temperature fixability and anti-offset characteristic, and a wide fixable temperature range. Col. 2, lines 14-17, and Table 3 at col. 23, example 9. Table 3 reports that the toner in example 9 provided toner images that were capable of being fixed at a temperature of 145°C and that no offset was observed when the toner images were fixed at temperatures ranging from 140 to 230°C. Accordingly, because the Onuma toner has "sufficient fixing performance," it is reasonable to presume that the Onuma wax composition has a "rationalized molecular weight distribution by including an appropriate amount of a low molecular weight wax component" as recited instant claims 1 and 5. The burden is on applicants to show otherwise. In re Fitzgerald, 205 USPQ 594 (CCPA 1980).

Onuma also does not disclose that its particular combination of waxes comprise a "low molecular weight wax" and a wax component having "a molecular weight which is higher than a molecular weight of the low molecular weight wax" as recited in instant claim 14. However, as discussed supra, the Onuma wax mixture comprises paraffin wax **J** and polypropylene wax **K**. Paraffin wax **J** has a maximum heat absorption peak, i.e., melting point, of 62°C, while polypropylene wax **K** has a maximum heat absorption peak of 129°C. Both waxes also have different onset temperatures of heat absorption. Because the two waxes have

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different thermal properties, it is reasonable to presume that the two waxes have two different molecular weights, one of which is higher than the other, which meets the limitation recited in instant claim 14. The burden is on applicants to prove otherwise. Fitzgerald, supra.

13. Claim 4 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Onuma.

Onuma discloses a toner as described in paragraph 12 above, which is incorporated herein by reference. As discussed in paragraph 12, the toner disclosed by Onuma comprises a styrene-n-butyl acrylate binder resin. The binder resin meets the fixing resin composition limitation "at least a vinyl copolymer" recited in instant claim 4.

Instant claim 4 is written in product-by-process format. Claim 4 recites that the vinyl copolymer "is polymerized in existence [sic] of the wax." Onuma does not exemplify making a toner as recited in instant claim 4. Rather, the toner in example 9 of Onuma is obtained by melt-kneading a mixture comprising the binder resin and the waxes in an extruder, cooling the melted mixture, pulverizing the cooled mixture, and

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classifying the pulverized composition to obtain toner particles. See example 9. However, as discussed above, the Onuma toner meets the compositional limitations recited in instant claim 4. Accordingly, the Onuma toner appears to be the same or substantially the same as the toner recited in instant claim 4. The burden is on applicants to prove otherwise. In re Marosi, 218 USPQ 289 (Fed. Cir. 1983); In re Thorpe, 227 USPQ 964 (Fed. Cir. 1985); MPEP 2113.

14. Applicants' arguments filed on May 16, 2006, applicable to the rejections over Onuma in paragraphs 12 and 13 above have been fully considered but they are not persuasive.

Applicants assert that Onuma does not teach that its wax combination comprises a "rationalized molecular weight distribution by including an appropriate amount of a low molecular weight wax component in said wax to maintain sufficient fixing performance" as recited in instant claims 1 and 5.

Applicants' assertion is not persuasive. For the reasons discussed in paragraph 12 above, a prima facie case has been established that the Onuma wax combination has the "rationalized molecular weight distribution" recited in instant claims 1 and 5. Since the PTO cannot conduct tests, the burden is

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properly shifted to applicants to come forward with objective evidence to distinguish the claimed subject matter with the reference material. Applicants have not provided any objective evidence to show that the Onuma wax combination does not have the "rationalized molecular weight distribution" recited in instant claims 1 and 5. Thus, for the reasons discussed in the rejection in paragraph 12 above, it is reasonable to presume that the Onuma wax combination comprises the rationalized molecular weight distribution as recited in instant claims 1 and 5. Applicants have not come forward with any objective evidence to show otherwise. Accordingly, the rejections over Onuma in paragraphs 12 and 13 above stand.

15. Claim 5 is rejected under 35 U.S.C. 102(b) as being anticipated by US 6,447,968 B1 (Ohno'968).

Ohno'968 discloses an image forming apparatus comprising a photosensitive drum **1**, which carries an electrostatic latent image, and a developing unit **4-1**, comprising a magnetic toner, wherein the developing unit develops the electrostatic latent image with the magnetic toner. Magnetic toner production example 1 at cols. 33-34; Fig. 1; and col. 35, line 55, to col. 36, line 11.

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Ohno'968 does not exemplify the particular toner recited in the instant claim. However, the instant claim does not positively recite that the apparatus comprises the particular toner. Instant claim 5 merely recites "a developing unit for developing the electrostatic latent image, using an electrostatic charge image developing toner." The particular toner recited in the instant claim does not distinguish the structural elements in the instantly claimed apparatus from those in the apparatus in Ohno'968. A material (i.e., the toner) worked upon by the apparatus does not limit the apparatus claims. "Inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." See MPEP 2115. It is well settled, as stated in Ex parte Masham, 2 USPQ2d 1647, 1648 (Bd. Pat. App. & Int. 1987) that "a recitation with respect to the material intended to be worked upon by a claimed apparatus does not impose any structural limitations upon the claimed apparatus which differentiates it from the prior art apparatus satisfying the structural limitations of that claimed." Accordingly, the particular toner recited in the instant claim does not distinguish the instantly claimed apparatus from the apparatus disclosed by Ohno'968.

Applicants' arguments filed on May 16, 2006, have been fully considered but they are not persuasive.

Applicants assert that Ohno'968 does not teach or suggest the toner recited in instant claim 5.

However, as discussed in the rejection above, instant claim 5 does not positively recite that the apparatus comprises the particular toner. Instant claim 5 merely recites "a developing unit for developing the electrostatic latent image, using an electrostatic charge image developing toner." Thus, the particular toner recited in instant claim 5 does not distinguish the structural elements in the instantly claimed apparatus from those in the apparatus disclosed by Ohno'968. Accordingly, the rejection of claim 5 stand.

16. Claim 20 would be allowable if rewritten or amended to overcome the objection set forth in paragraph 9, supra.

Claim 20 is allowable over the prior art of record.

As discussed in paragraph 12 above, Onuma teaches a toner comprising a plurality of wax components that satisfy formula (2) recited in instant claim 20, where at least one of the wax components has a melting point in the range of 50 to 120°C. However, Onuma does not teach or suggest that one of the wax components has a crystallinity of greater than 85% and less

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than 93% as recited in instant claim 20. Nor is there sufficient evidence in the present record for a person having ordinary skill in the art to reasonably presume that one of the Onuma waxes in the plurality of wax components has the required crystallinity recited in instant claim 20.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janis L. Dote whose telephone number is (571) 272-1382. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Mr. Nam Nguyen, can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry regarding papers not received regarding this communication or earlier communications should be directed to Supervisory Application Examiner Ms. Claudia Sullivan, whose telephone number is (571) 272-1052.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JLD
Jul. 21, 2006

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